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APPEALS & INTERFERENCES

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Board of Patent Appeals and Interferences
Commissioner for Patents
Washington, D.C. 20231

Re: Application Serial No.: 09/398,182
Appellants: Alan J. Rozlosnik, et al.
Title: Receipt Delivery System for Secure Depository
Docket No.: D-1118R2

Sir:

Please find enclosed the Brief of Appellants pursuant to 37 C.F.R. § 1.192 in triplicate for filing in the above-referenced application.

Please charge the fee required with this filing (\$320) and any other fee due to Deposit Account 04-1077.

Very truly yours,

Ralph E. Jocke
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D-1118R2

7/Appeal
Brief
G. Staley
1-22-02

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re Application of)
Alan J. Rozlosnik, et al.)
Serial No.: 09/398,182) Art Unit: 2876
Filed: September 17, 1999) Patent Examiner:
Title: Receipt Delivery System April A. Nowlin
for Secure Depository)

Board of Patent Appeals and Interferences
Commissioner for Patents
Washington, D.C. 20231

BRIEF OF APPELLANTS PURSUANT TO 37 C.F.R. § 1.192

Sir:

The Appellants hereby submit their Brief pursuant to 37 C.F.R. § 1.192, in triplicate,
concerning the above-referenced Application.

REAL PARTY IN INTEREST

The Assignee of all right, title and interest to the above-referenced Application is
Diebold, Incorporated, an Ohio corporation.

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RELATED APPEALS AND INTERFERENCES

Appellants believe that there are no related appeals or interferences pertaining to this matter.

STATUS OF CLAIMS

Claims 1-18 are pending in the Application.

Claims 1-3, 5-8, and 10-18 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Caldwell (US 4,754,126) in view of McCall (US 6,112,981).

Claims 4 and 9 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Caldwell in view of McCall and further in view of Imai et al. (US 5,898,155) (“Imai”).

These rejections were the only rejections present in the Office Action (“Action”) dated August 13, 2001, which was made Final. Appellants appeal the rejection of claims 1 through 18, inclusive.

STATUS OF AMENDMENTS

A final rejection was made August 13, 2001. No amendments to the claims were requested to be admitted after the final rejection.

SUMMARY OF INVENTION

Overview of the Invention

One of the embodiments of the present invention is directed to a method of presenting and removing a bank depository receipt. In the exemplary embodiment a printer (122) is operative to print a receipt reflecting a deposit transaction conducted at the bank depository. As shown in Figure 38, the printer (122) may include a paper drive (107). The paper drive is operative to move paper (109) as printing is conducted thereon. The printer arrangement may also include a cutter (111). The cutter is operative to cut the web of paper (109) that is moved through the printer.

The configuration of the paper path within the printer and the depository control panel (16) are such that printed receipts may be taken by a user from an overlying member (30) only in a manner which prevents a user from prematurely grasping the receipt or pulling out excessive paper. The configuration of the overlying member (30) is such that a user cannot fully grasp the receipt document until the document is printed. The structural arrangement and corresponding method of receipt removal help prevent a user from prematurely pulling on a receipt and damaging the printer or pulling out extra paper.

The overlying member (30) is part of an arrangement and configuration that minimizes the risk of user misuse. The overlying member (30) overlies an opening (113) in a wall (115) of the depository control panel (16). The overlying member extends downward from above the opening (113) to a lower edge (119). The length of the overlying member (30) from the opening (113) to the lower edge (119) is sufficient to enable a substantial portion of the receipt length to

extend therein. An interior surface of the overlying member (30) is disposed from an exterior wall surface (121) of the control panel a sufficient distance to enable the receipt to pass therethrough. However, the distance between the interior of the overlying member (30) and the exterior wall surface (121) is sufficiently small so that a user's fingers cannot be extended into the space therebetween. The overlying member (30), also shown in Figure 39, includes an aperture (125) that extends into the overlying member from the lower edge (119). The aperture (125) is generally centered relative to the path of the receipt paper and is sized to accept a user's thumb or other finger therein.

During the printing operation the printer (122) operates to print indicia on the paper (109) to produce the receipt. The printing is generally controlled responsive to a processor such that the length of a printed receipt does not extend substantially outward beyond the lower edge (119) of the overlying member (30). With the receipt in the position as shown in Figure 39 a user can extend their thumb or other finger through the aperture (125). As a result the receipt can be engaged in sandwiched relation between the finger of the user and the exterior wall surface (121) of the control panel underlying the receipt. Once the user has engaged the receipt and moved it further downward away from the underlying member as shown in phantom in Figure 39, the user is then able to grasp the receipt for removal.

The arrangement and method of operation enable a user to easily and successfully obtain a depository receipt yet safeguards against the user prematurely engaging the receipt and pulling out extra paper or damaging the printer.

CONCISE STATEMENT OF THE ISSUES PRESENTED FOR REVIEW

The questions presented in this appeal are:

- 1). Whether Appellants' claims 1-3, 5-8, and 10-18 are unpatentable under 35 U.S.C. § 103(a) over Caldwell in view of McCall.
- 2). Whether Appellants' claims 4 and 9 are unpatentable under 35 U.S.C. § 103(a) over Caldwell in view of McCall and further in view of Imai.

GROUPING OF CLAIMS

Claims 1 and 16 stand or fall together. Each of Appellants' other claims, 2-15 and 17-18 each constitute a separate group. Each of claims 1-18 recite at least one element, combination of elements, or step not found or suggested in the Caldwell, McCall, or Imai references, which patentably distinguishes the claims.

The rejected claims include three independent claims (claims 1, 16, and 18). Claims 2-15 depend from claim 1. Claim 17 depends from claim 16. All of the rejected claims 1-18 are reproduced in the Appendix.

ARGUMENT

The Applicable Legal Standards

Before a claim may be rejected on the basis of obviousness, the Patent Office bears the burden of establishing that all the recited features of the claim are known in the prior art. This is

known as *prima facie* obviousness. To establish *prima facie* obviousness, it must be shown that all the elements and relationships recited in the claim are known in the prior art. MPEP § 2142.

Absent a showing of a teaching, suggestion, or motivation to produce a claimed combination, an obviousness rejection is not proper. *Panduit Corp. v. Denison Mfg. Co.*, 810 F.2d 1561, 1568, 1 USPQ2d 1593 (Fed. Cir. 1987). *In re Newell*, 891 F.2d 899, 901, 902, 13 USPQ2d 1248, 1250 (Fed. Cir. 1989).

The teaching, suggestion, or motivation to combine the features in a prior art reference must be clearly and particularly identified in such prior art to support a rejection on the basis of obviousness. It is not sufficient to offer a broad range of sources and make conclusory statements. *In re Dembiczaik*, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999).

If the Office does not produce a *prima facie* case of obviousness, then the Appellants are under no obligation to submit evidence of nonobviousness. MPEP § 2142.

It is respectfully submitted that the Action from which this appeal is taken does not meet these burdens.

Caldwell

Caldwell is directed to receiving deposits in a night depository (14) which is operatively associated with an ATM (12). The depository signals the ATM when a deposit has been made. The ATM records the transaction and issues a receipt relating to the deposit on behalf of the depository.

The depository (14) rests upon a floor and is configured to provide an upper surface (16) upon which feet of the ATM (12) rest (Figure 1). The ATM includes a recessed customer interface (26) having a card slot (38) and a receipt slot (40). The depository includes a door (22).

McCall

McCall is directed to a bar code reader for a fuel dispenser. The fuel dispenser arrangement is adapted to accept bar coded cards in addition to or instead of magnetic strip cards. A bar code reader (94, 120) is able to read the bar coded data (82) on a bar coded card (80). A bar code reader (120) is also able to read bar coded data (132) from a receipt (130). For example, a customer may make purchases (including prepaid fuel) inside of a store and then receive a receipt having bar code data thereon indicating prepayment of the fuel. The customer may then place the receipt in front of the bar code reader (120) at the fuel dispenser to receive the prepaid amount of fuel.

Imai

Imai is directed to an ATM. The ATM includes a cutter (52) which performs cutting of paper from a receipt paper roll (41A).

(iv) 35 U.S.C. § 103

Appellants traverse the rejections on the grounds that Appellants' claims recite steps, features, and relationships which are neither disclosed nor suggested in the prior art, and because

there is no teaching, suggestion, or motivation cited so as to produce Appellants' invention. The steps, features, and relationships recited in Appellants' claims patentably distinguish over the applied references.

Appellants' arguments against the prior art rejections are based on the Office's interpretation of the references as indicated and applied in the Action. Therefore, it is respectfully submitted that any other interpretation of the references by the Office would constitute a new grounds of rejection.

Appellants' remarks in the amendments filed May 18, 2001 are herein incorporated by reference as if fully rewritten herein.

To establish *prima facie* obviousness, the prior art references must teach or suggest all the claim limitations. MPEP § 2142. Absent a showing of a teaching, suggestion, or motivation to produce a claimed combination, an obviousness rejection is not proper.

Appellants respectfully submit that none of the applied references, taken alone or in combination, disclose or suggest the steps, features, and relationships that are specifically recited in the claims. Additionally, even if it were somehow possible for the references to have disclosed certain features as alleged, it still would not have been obvious to have combined the references as alleged. Furthermore, even if it were somehow possible for the references to be combined as alleged, the resultant combination still would not have produced Appellants' claimed invention.

The Office has not presented a *prima facie* showing of obviousness. Therefore, the rejections are improper and should be withdrawn.

**The Pending Claims Are Not Obvious Over
Caldwell in view of McCall**

Claims 1-3, 5-8, and 10-18 were rejected under 35 U.S.C. § 103(a) as obvious over Caldwell in view of McCall. These rejections are respectfully traversed.

Caldwell does not disclose or suggest the steps, features, and relationships that are specifically recited in the claims. The Action relies on Caldwell to disclose a night depository method. However, the Action admits (on page 3) that Caldwell fails to teach "the use of a cover extending from a receipt dispensing slot, wherein the cover includes an aperture." That is, the Action not only admits that Caldwell fails to teach or suggest a cover (i.e., overlying member), but also a cover including an aperture.

The Action then alleges that it would be obvious to employ a night depository machine having a receipt delivery system with a cover. The Action then further alleges that McCall teaches a cover with an aperture. The Action then alleges that one would be motivated to add a cover with an aperture to prevent a receipt from being damaged from outside environment, to minimize infiltration of contaminants, and to prevent pulling out excessive paper, etc.

The Appellants disagree. McCall cannot overcome the admitted deficiencies of Caldwell as it does not disclose or suggest the recited features which are not found in Caldwell. Furthermore, the Action is silent as to how (and why) Caldwell could be modified by McCall to include the recited features and relationships. The Action is devoid of any such teaching, suggestion, or motivation for combining the references. Neither Caldwell nor McCall alone or in

combination disclose or suggest the steps, features, and relationships that are specifically recited in the claims.

The attempts to combine McCall with Caldwell is clearly an attempt at hindsight reconstruction of Appellants' claimed invention, which is legally impermissible and does not constitute a valid basis for a finding of obviousness. *In re Fritch*, 22 USPQ2d 1780 (Fed. Cir. 1992). The rejections, which lack the necessary evidence and rationale, are based on knowledge gleaned only from Appellants' disclosure. For example, a reason provided for the motivation to combine is "to prevent pulling out excessive paper". However, the only hint of such reasoning comes directly from Appellants' own novel disclosure. It follows that it would not have been obvious to one having ordinary skill in the art to have combined the references in the manner alleged. Furthermore, without a proper motivation to combine, which is the current situation, a rejection based on a *prima facie* case of obviousness is improper (MPEP § 2143.01). Thus, it is respectfully submitted that the 35 U.S.C. § 103(a) rejections should be withdrawn.

The applied references, taken alone or in combination, neither disclose nor suggest the recited steps, features, and relationships. Thus, it would not have been obvious to one having ordinary skill in the art to have combined the references to have produced the recited invention. The Office does not factually support any *prima facie* conclusion of obviousness. If the Office does not produce a *prima facie* case, then the Appellants are under no obligation to submit evidence of nonobviousness (MPEP § 2142). Appellants respectfully submit that such is the current situation. Therefore, the rejections are improper and should be withdrawn.

Claim 1

Claim 1 is an independent claim which is specifically directed to a method. The claim recites many steps which Caldwell does not disclose. For example, the claim specifically recites “extending a receipt intermediate of an exterior wall of the machine and an overlying member, wherein the overlying member includes an aperture therein sized for accepting a finger of a user.”

The Action alleges that Caldwell discloses a receipt dispensing slot (40). However, the Action admits (page 3, lines 3-4) that Caldwell does not teach or suggest the recited overlying member. That is, the Action admits that Caldwell fails to teach “the use of a cover extending from a receipt dispensing slot, wherein the cover includes an aperture.”

The Action also admits (sentence bridging pages 4 and 5) that McCall does not teach or suggest the recited overlying member for use in delivering a receipt. Therefore, if the Office admits that both references lack an overlying member in the manner recited, then how can the Office legally allege obviousness? To establish *prima facie* obviousness, it must be shown that all the elements and relationships recited in the claim are known in the prior art. MPEP § 2142. Thus, the Office has not presented a *prima facie* showing of obviousness and the rejection is without basis.

The applied art fails to teach or suggest a deposit accepting machine having a receipt delivery arrangement, especially one with a receipt printer in the interior of the machine. Any receipt printer in Caldwell would be affiliated with the ATM (12) not the depository (14). It follows that Caldwell does not have a receipt printer in the interior of the depository (14). Nor does Caldwell extend a receipt adjacent to an exterior wall of the depository (14).

The applied art also fails to teach or suggest an overlying member (referenced as a “cover” in the Action) in regard to a receipt at a deposit accepting machine. The applied art further fails to teach or suggest the overlying member having an aperture therein sized for accepting a finger of a user.

Neither Caldwell nor McCall, taken alone or in combination, disclose or suggest (1) a receipt printer in the interior of a deposit accepting machine; (2) an overlying member associated with a deposit accepting machine; (3) the overlying member having an aperture therein sized for accepting a finger of a user; (4) extending a receipt intermediate an exterior wall of the deposit accepting machine and the overlying member; or (5) moving the receipt in a sandwiched relation between a finger and the exterior wall of the machine, in the manner recited.

McCall is non analogous art

McCall is non analogous art. McCall is directed to a fuel dispenser (12). Claim 1 relates to deposit accepting. McCall’s dispensing is actually opposite to deposit accepting. Thus, McCall teaches away from the recited invention. It follows that it would not have been obvious to have combined the teachings of Caldwell and McCall to have produced Appellants’ recited invention.

McCall is also non analogous art because there is no indication that McCall is directed to moving a receipt at the fuel dispenser. Claim 1 is directed to moving a receipt. It follows that it would not have been obvious to have combined the teachings of Caldwell and McCall to have produced Appellants’ recited invention. The Office has not presented a *prima facie* showing of obviousness.

No evidence has been presented that McCall issues a receipt

There is no indication that McCall discloses or suggests issuing a receipt at the fuel dispenser (12). Before a claim may be rejected on the basis of obviousness, the Patent Office bears the burden of establishing that all the recited features of the claim are known in the prior art. The Office has not established that McCall's fuel dispenser issues a receipt. McCall's embodiments are directed to giving a customer a receipt while the customer is in the store and away from the fuel dispenser (12). In one embodiment (col. 5, lines 57-67) the customer makes purchases (including prepaid fuel) inside of the store and then receives a receipt having bar code data thereon indicating prepayment of the fuel. The customer then places the receipt in front of the bar code reader (120) at the fuel dispenser to receive the prepaid amount of fuel. In such an embodiment there would be no reason to provide another duplicate receipt at the fuel dispenser. Nor has the Action provided a prior art teaching or suggestion of receiving a receipt at a fuel dispenser after prepayment of fuel. It follows that McCall's teaching cannot be used with a receipt delivery system as alleged. It follows that it would not have been obvious to have combined the teachings of Caldwell and McCall to have produced Appellants' recited invention. The Office has not presented a *prima facie* showing of obviousness.

The Action's reasons for obviousness are not valid

The Action alleges that it would be obvious to employ a night depository machine having a receipt delivery system with a cover. The Action then alleges that one would be motivated to add the cover with an aperture, as allegedly taught by McCall, to protect the receipt delivery system from infiltration of contaminants.

It is unclear how one would be motivated to add an aperture to a cover of a receipt delivery system of a night depository machine to protect the receipt delivery system from infiltration of contaminants. It would appear that a cover without an aperture (e.g., solid cover) would provide the best protection against contaminants. It would appear that the addition of an aperture in the cover would actually increase the probability of entered contaminants. Thus, the alleged motivation for obviousness is inadequate. The Action's reasons for obviousness are flawed. Therefore, the Action has not presented a valid basis for obviousness. Furthermore, the Action's motivation for obviousness is impermissibly based on hindsight reconstruction of Appellants' claimed invention. Without a proper motivation to combine, which is the current situation, a rejection based on a *prima facie* case of obviousness is improper (MPEP § 2143.01). It follows that it would not have been obvious to have combined the teachings of Caldwell and McCall to have produced Appellants' recited invention.

No evidence has been presented of an overlying member including an aperture therein

The Action alleges that McCall teaches extending a receipt intermediate of an exterior wall of the machine and a cover (which allegedly serves as an overlying member). The Appellants disagree. The Office has not established that McCall discloses or suggests an overlying member with an aperture. Nor does McCall disclose or suggest an overlying member with an aperture.

The Action is silent as to where the alleged cover (alleged overlying member) is located in McCall. No evidence has been presented of an overlying member including an aperture therein. As previously discussed, before a claim may be rejected on the basis of obviousness, the

Patent Office bears the burden of establishing that all the recited features of the claim are known in the prior art. Furthermore, the features in prior art references must be clearly and particularly identified to support a rejection on the basis of obviousness (MPEP 707.07(d)). Appellants should not be forced to speculate as to what member constitutes the alleged cover (overlying member) in McCall. As this argument was previously made by Appellants, the Office had ample opportunity in the Action to clearly state on the record which component in McCall constitutes the alleged overlying member. However, the Office has chosen not to specify the alleged overlying member. The Action's failure to specifically indicate the alleged overlying member in the McCall reference constitutes Agency Action under the Administrative Procedures Act admitting that the reference does not teach or suggest the recited feature. For these reasons it is additionally respectfully submitted that the Action fails to establish a *prima facie* case of obviousness against the claim and the rejection should be withdrawn.

None of McCall's members can constitute the recited overlying member

Appellants' discussions involving the McCall reference are no admission that McCall actually discloses the mentioned features. Appellants do not waive any rights regarding the complete absence of any disclosure in McCall regarding a receipt delivery system or an overlying member including an aperture therein.

The Action admits that Caldwell fails to teach a depository receipt delivery system having an overlying member with an aperture. The Action relies on McCall as teaching a cover (overlying member) with an aperture. The Appellants disagree. As previously discussed, no evidence has been presented that McCall teaches extending a receipt intermediate of an exterior

wall of a deposit accepting machine and an overlying member. As no such showing has been made, the rejection is not in compliance with MPEP § 2142 and should be withdrawn.

Furthermore, the structure, function and operation of the (unreferenced) member in McCall's Figure 1 which is located below display (20a) and to the right of a reader device (22) is unclear. Thus, the structure and operation of McCall's unreferenced member are open to many different indefinite interpretations. Each such interpretation is purely speculative. Rejections cannot be based upon speculation or possibilities. *In re Robertson*, 169 F. 3d 749 (Fed. Cir. 1999). Nevertheless, said unreferenced member in McCall's Figure 1 cannot constitute the recited overlying member.

In one speculated interpretation of McCall's unreferenced member the uppermost (cup-shaped) portion of the unreferenced member appears to show that the unreferenced member may be recessed into the exterior wall (16) of the fuel dispenser. If this member was involved with delivering receipts (and there is no evidence that it is), at best, any receipt would appear to be interior of the exterior wall (16). However, claim 1 recites that a receipt is extended intermediate of an exterior wall and an overlying member. Hence, McCall (even if somehow possibly involved with delivering receipts) could not alleviate the admitted deficiencies in Caldwell. Thus, a combined Caldwell and McCall would still lack the recited steps, features, and relationships. It follows that it would not have been obvious to have combined the teachings of Caldwell and McCall to have produced Appellants' recited invention.

Furthermore, because the uppermost (cup-shaped) portion of the unreferenced member appears to show the member as being recessed (again a purely speculative interpretation), then

any receipt would have to be pulled through what may be an opening (e.g., U-shaped) in order to be obtained by a customer. That is, because of the recess a receipt could not be removed from the bottom of the member. Hence, a finger would have to be inserted behind a receipt in order to pull the receipt through the opening. In McCall, at best, any possible receipt would be in sandwiched relation between a first finger and a second finger (e.g., thumb). Therefore, McCall would also lack the recited step of moving a receipt in sandwiched relation between a finger and the exterior wall. Hence, McCall cannot alleviate the admitted deficiencies in Caldwell. Thus, a combined Caldwell and McCall would still lack the recited steps, features, and relationships. It follows that it would not have been obvious to have combined the teachings of Caldwell and McCall to have produced Appellants' recited invention.

Additionally, in another (second) speculative interpretation, the unreferenced member in McCall's Figure 1 which is located below display (20a) and to the right of a reader device (22) may constitute a door for restricted access to the interior of the fuel dispenser. In such a second speculated interpretation, McCall is not even involved with a receipt.

In still another (third) speculative interpretation, said unreferenced member in McCall may constitute a clear plastic drawer which can be either tilted outward or slid upwardly by a customer to enable the customer to gain access to a receipt in the recessed interior portion. In such a third speculated interpretation, any receipt would not be moved in sandwiched relation.

In still another (fourth) speculative interpretation, said unreferenced member in McCall may constitute an outlet for presenting coupons, without involving a receipt.

In still another (fifth) speculative interpretation, the unreferenced member in McCall may somehow be part of a bill acceptor which enables a user to pay by inserting cash into the machine.

As previously discussed, McCall does not teach or suggest the recited overlying member having an aperture. Furthermore, even with the best speculative interpretation of McCall's unreferenced member, McCall would still not teach or suggest the recited overlying member having an aperture. It follows that no matter which speculated interpretation of the unreferenced member in McCall is used, even if it were somehow possible for Caldwell to include the teachings of McCall, the modified Caldwell would still lack the recited steps, features, and relationships. McCall cannot alleviate the admitted deficiencies in Caldwell. Therefore, it would not have been obvious to have combined the teachings of Caldwell and McCall to have produced Appellants' recited invention.

The Office has not presented a *prima facie* showing of obviousness. Therefore, the rejection is improper and should be withdrawn.

Caldwell has no need for a cover

The Action alleges that Caldwell discloses a receipt dispensing slot (40). However, the Action admits that Caldwell fails to teach "the use of a cover extending from a receipt dispensing slot, wherein the cover includes an aperture."

Caldwell has no need for a cover. Caldwell's receipt dispensing slot (40) is already protected by the recessed customer interface (26). Caldwell also lacks the structural space

necessary to permit an overlying member and its use. Additionally, the slot (40) permits a receipt to be directly presented to a customer. It appears that the arrangement enables a customer to easily grasp the presented receipt by hand. In Caldwell it is not necessary (nor desired) to move the receipt in the recited sandwiched relation.

Furthermore, Caldwell does not structurally permit moving a receipt in the recited sandwiched relation. This is because Caldwell does not disclose or suggest an overlying member with an aperture (or even an overlying member) in the manner recited. Even the Action admits that Caldwell fails to teach or suggest a depository receipt delivery system having a cover with an aperture. Thus, the Action is devoid of any such teaching, suggestion, or motivation for extending a cover (overlying member) from Caldwell's receipt dispensing slot (40) as alleged. It follows that it would not have been obvious to have combined the teachings of Caldwell and McCall to have produced Appellants' recited invention.

The alleged modification to Caldwell would destroy the disclosed utility of Caldwell

As previously discussed, it would not have been obvious to have added McCall's teaching to Caldwell. Nevertheless, even if it were somehow possible for Caldwell to include the teachings of McCall, the modified Caldwell would still lack the recited steps, features, and relationships. For example, the combined Caldwell would still lack the capability of moving a receipt in a sandwiched relation between a finger and the exterior wall of the machine in the manner recited.

As previously discussed, Caldwell's receipt dispensing slot (40) is protected by a recessed customer interface (26). Additionally, a receipt would appear to exit the slot (40) in a horizontal

direction toward the customer (i.e., generally perpendicular to the slot housing). A modification of Caldwell with the alleged cover teaching of McCall would change the desired direction of a receipt exiting Caldwell's slot (40).

If it were somehow possible for the unreferenced member in McCall to present a receipt intermediate of an exterior wall of the machine and a cover as alleged, then the receipt would not be presented in the same direction as Caldwell's receipt. It follows that even if it were somehow possible for McCall's unreferenced member to be a receipt dispenser and it was added to the structure of Caldwell, then the modified Caldwell would not present a receipt in the same direction as the unmodified Caldwell. Modification of Caldwell with McCall's unreferenced member as alleged would not permit a receipt to be presented to a customer in the direction (generally perpendicular to the slot housing) desired in Caldwell. That is, the alleged modification to Caldwell would destroy the disclosed and desired utility or operability of the Caldwell teaching.

An obviousness rejection cannot be based on a combination of features in references if making the combination would result in destroying the utility or advantage of the device shown in the prior art references. Note *In re Fine*, 5 USPQ2d 1598-99 (Fed. Cir. 1988). Therefore, it would not have been obvious to have combined the teachings of Caldwell and McCall to have produced Appellants' recited invention.

The alleged cover of McCall is not capable of fitting into the structure of Caldwell

Furthermore, the alleged cover of McCall is not capable of fitting into the compact (and perhaps away-angled) interface structure of Caldwell. The location and arrangement of

Caldwell's slot (40) would prevent the alleged modification. Caldwell's entire interface structure and receipt delivery system would have to be dramatically modified to be able to present a receipt intermediate of an exterior wall of the machine and a cover as alleged. Additionally, if Caldwell's slot interface is angled away from the customer, then one skilled in the art would not have attempted to modify the structure of Caldwell to require moving a receipt in a sandwiched relation, because the receipt would have to be moved in a direction away from the customer. Hence, the alleged modification to Caldwell would destroy the operability of the desired Caldwell arrangement. As previously discussed, an obviousness rejection cannot be based on a combination of features in references if making the combination would result in destroying the utility or advantage of the device shown in the prior art references.

Furthermore, such an alleged modification would clearly be an attempt at hindsight reconstruction of Appellants' claimed invention, which is impermissible. The Action has not shown any reason or motivation to combine, or explained how the incompatible (alleged) structure of McCall could be incorporated into the structure of Caldwell. The Action has not shown any reason or motivation why one skilled in the art would even attempt to merge incompatible features, which would require a dramatic and destructive change to the structure of Caldwell.

Appellants have shown that the claim is patentable over Caldwell in view of McCall

Appellants have shown that neither Caldwell nor McCall, taken alone or in combination, disclose or suggest extending a receipt intermediate of an exterior wall of a deposit accepting

machine and an overlying member in the manner recited. Nor a receipt printer in the interior of the machine.

Appellants have also shown that neither Caldwell nor McCall, taken alone or in combination, disclose or suggest extending a receipt intermediate of an exterior wall of the machine and an overlying member, wherein the overlying member includes an aperture therein sized for accepting a finger of a user in the manner recited.

Appellants have also shown that neither Caldwell nor McCall, taken alone or in combination, disclose or suggest moving a receipt in a sandwiched relation between a finger and the exterior wall of the machine in the manner recited.

As previously discussed, the Office has not presented a *prima facie* showing of obviousness. Appellants have also shown that neither Caldwell nor McCall disclose or suggest the recited steps, features, and relationships. Nor would it have been obvious to one having ordinary skill in the art to have combined the teachings of Caldwell and McCall. Nor would it have been obvious to one having ordinary skill in the art to have modified Caldwell with the teaching of McCall to have produced Appellants' recited invention. Furthermore, Appellants have also shown that even if it were somehow possible for Caldwell to include the teachings of McCall, the modified Caldwell would still lack the recited steps, features, and relationships. It follows that neither Caldwell nor McCall, taken alone or in combination, disclose or suggest the steps, features, and relationships that are specifically recited in the claim. Therefore, Appellants respectfully submit that the 35 U.S.C. § 103(a) rejection should be withdrawn.

Claim 2

Claim 2 depends from claim 1. The Action admits that Caldwell fails to teach or suggest a depository receipt delivery system having a cover with an aperture. The Action is silent as to where McCall discloses or suggests the recited overlying member including an aperture (and edge). Nor does McCall disclose or suggest the recited overlying member of claim 2. Therefore, McCall cannot be relied upon to teach or suggest an overlying member including an aperture extending from an edge, and moving a receipt in sandwiched engagement in the manner recited. Hence, McCall cannot alleviate the admitted deficiencies of Caldwell. It follows that the applied references, taken alone or in combination, cannot disclose or suggest the recited steps. Hence, the Office has not presented a *prima facie* showing of obviousness.

Claim 3

Claim 3 depends from claim 2. The Office has not presented any evidence of moving a receipt in the manner recited. The Action admits that Caldwell lacks the recited steps, features, and relationships. Nor has the Office shown that McCall discloses or suggests the recited steps, features, and relationships. Therefore, McCall cannot be relied upon to teach or suggest an overlying member including an aperture extending from an edge, and moving a receipt in generally a downward direction in the manner recited. As previously discussed, Caldwell lacks the structural space necessary to permit an overlying member and its use. The Action lacks any evidence that the combination of references would result in a receipt being able to be moved in a downward direction in Caldwell. It would appear that an overlying member in a modified Caldwell, if somehow even possible, would likely result in the movement of a receipt in an

upward direction instead of the recited downward direction. Nevertheless, as previously discussed, the alleged modification to Caldwell would destroy the operability of the desired Caldwell arrangement. It follows that it would not have been obvious to one having ordinary skill in the art to have modified Caldwell with the teaching of McCall to have produced Appellants' recited invention.

Claim 5

Claim 5 depends from claim 4. The Action admits (page 4, first paragraph) that the combination of Caldwell and McCall lacks the recited steps, features, and relationships of claim 4. If these applied references lack the features of claim 4, then it follows that these same applied references also lack the features of claim 5 which depends from claim 4.

Claim 6

Claim 6 depends from claim 1. Neither Caldwell nor McCall disclose or suggest the relationships of the overlying member, aperture, exterior wall, and opening. Nor do the applied references disclose or suggest moving a receipt downward in the manner recited. As previously discussed, an overlying member in a modified Caldwell, if somehow even possible, would likely result in the movement of a receipt in an upward direction instead of the recited downward direction. The Action's reliance on McCall to teach the exterior wall opening and overlying member relationship is lacking. For example, where does McCall show an overlying member extending generally above an exterior wall opening? To establish *prima facie* obviousness, it must be shown that all the elements and relationships recited in the claim are known in the prior art. MPEP § 2142. Thus, the Office has not presented a *prima facie* showing of obviousness.

Claim 7

Claim 7 depends from claim 1. The Action relies on McCall for showing an overlying member, aperture, and exterior wall relationship such that a receipt cannot be manually grasped with fingers prior to moving the receipt by engagement with a finger through the aperture. However, where does McCall teach or suggest the prevention of manually grasping a receipt with fingers prior to it being moved by engagement with a finger? As previously discussed, no evidence has been presented that McCall even teaches extending a receipt intermediate of an exterior wall of a deposit accepting machine and an overlying member. Nevertheless, even if it were somehow possible for McCall's unreferenced member to be a receipt dispenser (which was previously discussed as pure speculation), there would still be no evidence that the receipt would be prevented from being manually grasped with fingers prior to it being moved by engagement with a finger. The speculative size and arrangement of McCall's unreferenced member would not permit the recited steps, features, and relationships. In an example of a disclosed embodiment, Figure 39 shows an arrangement of an aperture (125) and an overlying member (30) that permits the recited steps, features, and relationships. As the Office has not presented a *prima facie* showing of obviousness, it is respectfully submitted that the 35 U.S.C. § 103(a) rejection should be withdrawn.

Claim 8

Claim 8 depends from claim 6. Neither of the applied references, taken alone or in combination, disclose or suggest the arrangement of the aperture and overlying member in the manner recited. Nor do the applied references disclose or suggest moving a receipt downward by

movement of a thumb. As previously discussed, an overlying member in a modified Caldwell, if somehow even possible, would likely result in the movement of a receipt in an upward direction instead of the recited downward direction. Thus, it would not have been obvious to one having ordinary skill in the art to have combined the references. Nor would the combined references have produced the claimed invention.

Claim 10

Claim 10 depends from claim 1. The Action relies on Caldwell's inputting of a personal identification number (PIN) as constituting the recited inputting of an article identifying number. The Appellants disagree. In Caldwell a customer chooses a "commercial deposit" transaction, then enters an appropriate amount on the keyboard and signals "ready" by using a function key as shown in the block (132) (col. 5, lines 60-68) (Figure 7A). There is no indication in Caldwell that indicia printed on the receipt includes the PIN (alleged article identifying number). Nor would it have been obvious to one having ordinary skill in the art to have their (highly valuable and secret) PIN printed on a receipt. Thus, the Office has not presented a *prima facie* showing of obviousness.

Claim 11

Claim 11 depends from claim 1. The Action relies on Caldwell as teaching the recited features. However, there is no direct indication in Caldwell that indicia printed on the receipt includes an inputted amount. Caldwell appears more concerned with the receipt providing a dated record as evidence that the customer attempted a deposit at a certain time. Again, the Office has not presented a *prima facie* showing of obviousness.

Claim 12

Neither of the applied references, taken alone or in combination, disclose or suggest conducting a transaction at a depository in the manner recited. It would not have been obvious to one having ordinary skill in the art to have combined the references to have produced the claimed invention. Thus, the 35 U.S.C. § 103(a) rejection should be withdrawn.

Claim 13

Claim 13 depends from claim 12. Neither of the applied references, taken alone or in combination, disclose or suggest unlocking a depository door responsive to both the input of a card and a key. The Action alleges that Caldwell discloses a key lock (56) at col. 3, lines 59-64. However, Caldwell at col. 3, lines 57-64 states that the depository door (22) is controlled by the ATM or alternatively by a key lock. It follows that Caldwell's depository door (22) is not controlled by both the ATM and the key lock. Again, the Office has not presented a *prima facie* showing of obviousness.

Claim 14

Neither of the applied references, taken alone or in combination, disclose or suggest fitting a panel on an exterior surface of an existing deposit accepting machine, wherein the printer is housed in the panel, in the manner recited. In an example of a disclosed embodiment, a control panel is retrofit to an existing depository. McCall is not associated with a deposit accepting machine. There is no indication that Caldwell discloses or suggest retrofitting. The Action states (page 2) that Caldwell has a depository (14). However, there isn't any indication that Caldwell's depository (14) has a panel or is able to have a panel. In Caldwell any panel

would be associated with the customer interface area (26) of the ATM (12), not the depository (14). It follows that it would not have been obvious to one having ordinary skill in the art to have combined the references to have produced the claimed invention. Thus, the 35 U.S.C. § 103(a) rejection should be withdrawn.

Claim 15

Claim 15 depends from claim 14. The Action relies on Caldwell as teaching the recited features. However, there is no direct indication in Caldwell that receipt indicia includes an inputted value. As previously discussed, Caldwell appears more concerned with the receipt providing a dated record as evidence that the customer attempted a deposit at a certain time. Furthermore, as previously discussed, neither of the applied references, taken alone or in combination, disclose or suggest having a panel on the exterior surface of a deposit accepting machine. It follows that the Office has not presented a *prima facie* showing of obviousness.

Claim 16

Claim 16 is an independent method claim. Claim 16 recites subject matter similar to subject matter in claim 1. Appellants' remarks in support of the patentability of claim 1 are incorporated by reference as if fully rewritten herein. Thus, it is respectfully submitted that claim 16 also patentably distinguishes over the applied references. Thus, the 35 U.S.C. § 103(a) rejection should be withdrawn.

Claim 17

Claim 17 depends from claim 16. Neither of the applied references, taken alone or in combination, disclose or suggest the relationships of an overlying member, a generally

downward facing edge, an exterior wall, and an opening in the manner recited. Nor would the combination of references permit removal of a receipt in a generally downward direction through the opening. As previously discussed, an overlying member in a modified Caldwell, if somehow even possible, would likely result in the movement of a receipt in an upward direction instead of the recited downward direction. It follows that it would not have been obvious to one having ordinary skill in the art to have combined the references to have produced the claimed invention. Thus, the 35 U.S.C. § 103(a) rejection should be withdrawn.

Claim 18

Claim 18 is an independent method claim. Claim 18 includes a combination of subject matter from claims 3, 6, 7, and 16. Appellants' remarks in support of the patentability of these claims are incorporated by reference as if fully rewritten herein. As previously discussed, neither Caldwell nor McCall, taken alone or in combination, disclose or suggest the steps, features, and relationships that are specifically recited in any of claims 3, 6, 7, and 16. It follows that neither Caldwell nor McCall, taken alone or together, can disclose or suggest the combination of steps, features, and relationships that are specifically recited in claim 18. The Office has not presented a *prima facie* showing of obviousness. Claim 18 patentably distinguishes over the applied references. Thus, Appellants respectfully submit that the 35 U.S.C. § 103(a) rejection should be withdrawn.

**The Pending Claims Are Not Obvious Over
Caldwell in view of McCall and Imai**

Claims 4 and 9 were rejected under 35 U.S.C. § 103(a) as obvious over Caldwell in view of McCall and further in view of Imai. These rejections are respectfully traversed.

As previously discussed, neither Caldwell nor McCall alone or in combination disclose or suggest the features and relationships that are specifically recited in the claims.

Furthermore, even the Action admits that Caldwell as modified by McCall "fails to teach a receipt printed on paper supplied from a roll, wherein the paper is cut with a cutter to separate the receipt from the roll."

Claim 4

Claim 4 is directed to cutting paper with a cutter. Imai does not disclose or suggest cutting paper prior to moving a receipt in sandwiched relation in the manner recited. Imai cannot alleviate the admitted deficiencies in Caldwell (as modified by McCall). Therefore, it would not have been obvious to have combined the teachings of Caldwell and McCall and Imai to have produced Appellants' recited invention.

Claim 9

Claim 9 is directed to cutting a receipt with a cutter. Imai does not disclose or suggest that movement of a receipt in sandwiched relation is operative to cut the receipt in the manner recited. Imai cannot alleviate the admitted deficiencies in Caldwell (as modified by McCall). Therefore, it would not have been obvious to have combined the teachings of Caldwell and McCall and Imai to have produced Appellants' recited invention.

**Additional comments with respect to the
"Response to Arguments" section of the Action**

As previously discussed, the Action admits that Caldwell fails to teach an overlying member with an aperture. The Action also admits (sentence bridging pages 4 and 5) that McCall does not teach or suggest an overlying member intended to be used for delivering a receipt. Even though the Action admits that the McCall reference lacks the feature for which it was applied, the Action nevertheless tries to make up the difference by stating that "it is well known in the art that an overlying member with an aperture for a receipt dispenser exist." In an attempt to provide (prior art?) examples, the Action then alleges that a "fuel dispenser at gas station and automatic teller machines have a receipt dispenser including an overlying member with an aperture."

The Office is required to show factual prior art evidence instead of imaginary examples, pure speculation, and unwarranted allegations. On one hand the Office (correctly) admits that neither Caldwell nor McCall disclose or suggest an overlying member in the manner recited, yet on the other hand alleges that the recited overlying member is somehow well known (even though no prior art evidence has been presented). Such rejections are improper.

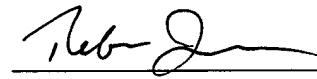
Also, the Action's language regarding the "examiner feels that it would be obvious" (page 5, lines 11 and 14) has been noted. In all due respect, neither the statutes, rules, nor Office procedures permit an Examiner's feelings to constitute a proper basis for denying a patent.

Appellants respectfully submit that the Action's unwarranted allegations and disregard for the statutes, rules, and Office procedures are reflective of the impropriety of all the rejections in the Action from which this appeal was taken.

CONCLUSION

As explained above, each of the claims specifically recites features, relationships, and steps that are neither disclosed nor suggested in any of the applied art. Furthermore, the applied art is devoid of any such teaching, suggestion, or motivation for combining features of the applied art so as to produce Appellants' invention. For these reasons it is respectfully submitted that all the pending claims are allowable.

Respectfully submitted,



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APPENDIX

CLAIMS

1. A method comprising the steps of:
 - (a) conducting at least one transaction at a deposit accepting machine;
 - (b) printing a receipt including indicia corresponding to the transaction with a printer in an interior area of the machine;
 - (c) extending a receipt intermediate of an exterior wall of the machine and an overlying member, wherein the overlying member includes an aperture therein sized for accepting a finger of a user;
 - (d) moving the receipt in sandwiched relation between a finger extended in the aperture and the exterior wall to remove the receipt from between the exterior wall and the overlying member.
2. The method according to claim 1 wherein the overlying member includes an edge, and wherein the aperture extends into the overlying member from the edge, and wherein in step (d)

the receipt is moved by a finger moving from inside the aperture to outside the aperture with the receipt in sandwiched engagement between the finger and the exterior wall.

3. The method according to claim 2 wherein the edge of the member is a downward facing edge, and wherein in step (d) the receipt is moved with a finger moving in generally a downward direction.

4. The method according to claim 1 wherein the receipt is printed on paper supplied from a roll and prior to step (d), further comprising the step of, cutting the paper with a cutter to separate the receipt from the roll.

5. The method according to claim 4 wherein the overlying member terminates in an edge, and wherein the cutting step is executed when the receipt extends below the aperture but not substantially below the edge.

6. The method according to claim 1 wherein the exterior wall includes an opening, and wherein in step (c) the receipt extends through the opening, and wherein the overlying member extends from generally above the opening to an edge positioned below the opening, wherein the aperture extends below the opening, and wherein in step (d) the receipt is moved downward by movement of the finger in the aperture.

7. The method according to claim 1 wherein the overlying member is disposed in proximity to the exterior wall such that a receipt extending therebetween cannot be manually grasped with fingers prior to moving the receipt by engagement with a finger through the aperture, and thereafter further comprising manually grasping the receipt.

8. The method according to claim 6 wherein the aperture extends in the overlying member from the edge, is generally centered relative to the receipt, and is sized for accepting a thumb therein, wherein in step (d) the receipt is moved by downward movement of the thumb.

9. The method according to claim 1 and further comprising the step of:

cutting the receipt with a cutter, wherein movement of the receipt in step (d) is operative to cut the receipt.

10. The method according to claim 1 wherein in step (a) conducting the transaction includes depositing an article in the machine and inputting an article identifying number through an input device, and wherein in step (b) the indicia printed on the receipt includes the article identifying number.

11. The method according to claim 1 wherein in step (a) conducting the transaction includes depositing an article in the machine and inputting through an input device at least one amount

associated with the article, and wherein in step (b) the indicia printed on the receipt includes the amount.

12. The method according to claim 1 wherein in step (a) conducting the transaction includes opening a depository door to a depository and placing a deposit article in the opening.

13. The method according to claim 12 wherein in conducting the transaction in step (a) the depository door is unlocked prior to opening, and wherein the depository door is unlocked responsive to both input of a card to a card reader in operative connection with the depository door and placing a key in a key actuator in operative connection with the depository door.

14. The method according to claim 1 and prior to step (a) further comprising the step of fitting a panel on an exterior surface of an existing deposit accepting machine, wherein the printer is housed in the panel.

15. The method according to claim 14 wherein the panel on the exterior surface of the existing deposit accepting machine includes at least one input device, and wherein the transaction conducting in step (a) includes inputting at least one value through the input device, and wherein the indicia printed in step (b) includes the input value.

16. A method comprising the steps of:

- (a) extending a printed receipt intermediate of an exterior wall of a deposit accepting machine and an overlying member, wherein the overlying member includes an aperture therein sized for accepting a finger of a user; and
- (b) moving the receipt in sandwiched relation between a finger extended in the aperture and the exterior wall to remove the receipt from between the exterior wall and the overlying member.

17. The method according to claim 16 wherein the overlying member includes a generally downward facing edge, wherein an opening is formed between the edge and the exterior wall, and wherein in step (b) the receipt is removed in a generally downward direction through the opening.

18. A method comprising:

- (a) extending a printed receipt intermediate of an exterior wall of a deposit accepting machine and an overlying member, wherein the overlying member includes an aperture therein sized for accepting a finger of a user, wherein the exterior wall

includes an opening, wherein the overlying member extends from generally above the opening to a generally downward facing edge positioned below the opening, wherein the aperture extends below the opening;

- (b) moving the receipt in sandwiched relation between a finger extended in the aperture and the exterior wall to remove the receipt from between the exterior wall and the overlying member, wherein the receipt is moved generally downward by movement of the finger in the aperture, wherein the overlying member is disposed in proximity to the exterior wall such that a receipt extending therebetween cannot be manually grasped adjacent the edge with fingers prior to moving the receipt by engagement with a finger through the aperture;
- (c) subsequent to (b), manually grasping the receipt.